IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor:	ZOLLER, PANU K.		
Application No.:	10/817,439	Confirmation No.:	2823
Filed:	April 1, 2004	Group Art Unit:	1772
Title:	ROLL STABILIZING RELEASE LINER		

PRE-APPEAL BRIEF and REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]

I hereby certify that this correspondence is being:

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July 23, 2007 /Kathleen M. Murray/

Date Signed by: Kathleen M. Murray

Dear Sir:

In response to the final action dated April 23, 2007, and the Advisory Action dated July 5, 2007, and prior to filing an appeal brief, a Panel Review of the legal and factual basis of the rejections in the above-identified application is hereby requested.

No amendments are being filed with this request.

This Pre-Appeal Brief and Request for Review is being filed with a Notice of Appeal.

Fees

☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.

☒ Please credit any overpayment to the same deposit account.

Reasons in support of Applicants' Request for Pre-Appeal Brief Request for Review

Applicants request review of the final rejection in the above-identified application. Applicants respectfully submit that the Examiner has failed to show how the cited references describe, teach, or suggest all elements of the claimed invention; thus the rejections under 35 U.S.C. § 103(a) are legally insufficient and clearly erroneous.

Background

The present application relates to adhesive articles including both a pressure sensitive adhesive (PSA) and a heat activatable adhesive (HAA) on opposite sides of a substrate. The articles include a release liner having a release surface and a roll stability layer. The release layer is provided for contact with and protection of the PSA. The roll stability layer contacts the HAA when the adhesive article is wound upon itself to form a roll. (See, e.g., FIG. 1 and the description at col. 4, lines 39-58.)

U.S. Patent No. 5,178,924 (Johnson1) describes a release liner having a release surface intended to contact a PSA and a "friction enhancing agent" for roll stability. The only friction enhancing agent mentioned by Johnson1 is a tackified ethylene acrylic acid (EAA) material. (See Johnson1, at col. 4, line 67 – col. 5, line 24.)

The Examiner has failed to show how Johnson1 describes, teaches, or suggests a roll stability layer comprising Ethylene Vinyl Acetate

Contrary to Johnson1, each claim of the present application requires a roll stability layer comprising an ethylene vinyl acetate (EVA).

The Examiner acknowledges that Johnson1 fails to teach a backside stability layer comprising EVA. To overcome this admitted deficiency, the Examiner asserts that

(1) Johnson1 discloses that the backside of the release liner is provided with a layer of EAA to provide roll stability; and

(2) Johnson1 discloses that the release material can be ethylene acrylic acid (EAA) or EVA.

From this, the Examiner concludes that "it would have been obvious to one of ordinary skill in the art to use EVA as the release material, instead of EAA, because the two are functionally equivalent as the friction reducing release material and would provide roll stability." (Office

Action mailed September 16, 2006, and maintained in the Final Office Action of April 23, 2007, emphasis added.)

Applicants respectfully submit that the Examiner's reliance on the purported functional equivalence of EAA and EVA as the basis for its obviousness rejection is contrary to Patent Office procedures and governing precedent.

MPEP § 2144.06 addresses the issue of "Substituting Equivalents Known for the Same Purpose." According to the MPEP, "In order to rely on equivalence as a rational supporting an obviousness rejection the equivalence must be recognized in the prior art, and cannot be based on … the mere fact that the components at issue are functional or mechanical equivalents." (Emphasis added, citing *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).)

When considering the description in Johnson1, it is important to maintain the clear distinction between the "release layer" and the "friction enhancing agent." Applicants note that the passage cited by the Examiner that purportedly teaches the functional equivalence of EAA and EVA (i.e., col. 4, lines 54-66) merely provides "illustrative examples of homopolymers and copolymers that may be used in the release layer of the release liner." Applicants respectfully submit that this list is similar to a Markush group and, as held in *In re Ruff*, "it is no longer possible to indulge in a presumption that members of a Markush group are recognized by anyone to be equivalents except as they possess at least one property in common which is mainly responsible for their function in the claimed relationship." (256 F.2d at 599, 118 USPQ at 348.)

At best, this text of Johnson1 might suggest that the items included may be useful as release layers; however, even if the Patent Office were to maintain its position that Johnson1 discloses that the listed materials are functionally equivalent as release materials, this is legally insufficient to establish that Johnson1 describes, teaches, or suggests that any of the materials on this list of release materials are functionally equivalent for any other purpose. Specifically, the Examiner has failed to show how Johnson1 describes, teaches, or suggests that EAA and EVA are functionally equivalent as friction enhancing agents.

In a telephonic interview with Examiner Nasser, Applicants pointed out that Johnson1 includes both EVA and high density polyethylene (HDPE) in the list of possible release materials. Thus, by the Examiner's reasoning, these materials would be "functional equivalents." However, as shown in the present application, EVA and HDPE do not perform equivalently as a roll stability layer. This evidence demonstrates the need to avoid broad

conclusions of general equivalence, based on the purported equivalence for a single purpose and exemplifies the risks sought to be avoided by the mandates of MPEP § 2144.06.

In summary, the Examiner has failed to show how Johnson1 describes, teaches, or suggests the use of EVA as a roll stability layer or as a friction enhancing agent. The mere fact that Johnson1 may describe EVA and EAA as alternatives for use as a **release material** is not a legally sufficient basis for asserting that they are art-recognized equivalents for any other purpose. Therefore, as the Examiner relies solely on Johnson1 for a purported teaching of EVA as a roll stability layer, all pending rejections are unwarranted and should be reversed.

Conclusion

By setting forth the clear grounds of error, Applicants do not assert that these are the only errors, nor do Applicants waive any arguments that may be asserted in an Appeal Brief. Accordingly, Applicants reserve the right to present additional arguments in the Appeal Brief in relation to the independent and also the dependent claims.

Applicants respectfully request that the Panel review and reverse all pending final rejections in the above-identified application, and that a Panel Decision allowing the application on the existing claims be issued.

Respectfully submitted,

July 23, 2007
Date

By: /Thomas M. Spielbauer/
Thomas M. Spielbauer, Reg. No.: 58,492
Telephone No.: 651-736-9814

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833